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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,635	06/30/2000	Joan A. Schuller	6258/9	9395
27383	7590	04/07/2004	EXAMINER	
CLIFFORD CHANCE US LLP 200 PARK AVENUE NEW YORK, NY 10166			CHANG, SABRINA A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/608,635

Applicant(s)

SCHULLER, JOAN A.

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-16 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

Applicant's amendment to claims 6 and 20 have been fully considered.

***Response to Arguments***

Applicant's arguments filed 1/23/04 have been fully considered but they are not persuasive.

**Improper combination of references**

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant asserts that the examiner's motivation for combining the references Eastman Chemical and Blendpro, i.e. "in order to avoid a lengthy and inaccurate development process and further to aid the customer in efficiently keeping up with changing technical requirements" was improper. The examiner respectfully disagrees. The article discusses on the second page the effects of federal regulation on the specifications of different solvents. "A tool such as Shell's Blendpro computer programme can assist the formulator in achieving the required results" [Page 2, Fifth full paragraph]. In the third full paragraph of the sixth page of the "Blendpro" article, the author explicitly states "By using the Shell Blendpro, the time of the

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development process involving lengthy trial and error laboratory tests was reduced dramatically.” Further, in the conclusion of the article the author states “although the technical requirements for solvents in the various end-use applications are changing, both chemical solvents and hydrocarbon solvents play an important role in the new generation of technologies currently being developed. A reformulation tool like Shell’s computer programme Blendpro can assist in making these developments *as efficient as possible*.”

The benefits, for a formulator, of using the Blendpro software are made clearly apparent in the Beers et al. article: dramatically reducing time of the development process – which normally involves lengthy trial and error tests – and developing solvents that meet technical as well as regulatory specifications as efficiently as possible. The examiner respectfully asserts that the statement of motivation, provided in paper 15 – 11/19/03, in combining the BlendPro reference with the chemical purchasing system of Eastman, thereby providing this tool to formulators, is commensurate with the benefits explicitly discussed by the Beers et al. article.

- “in order to avoid a lengthy and inaccurate development process...” – i.e. the lengthy trial and error process typified in formulating a solvent with particular desired specifications
- “and further to aid the customer in efficiently keeping up with changing technical requirements” – i.e. real-time calculation of solvent formulas in response to a user’s input allows a formulator to more easily adapt to changing technical requirements, whether they be performance-based or regulation-mandated.

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Inadequacy of combination

Eastman discloses an independent Internet marketplace for the paint and coatings industry. Availability of an e-commerce website inherently comprises: a plurality of client computers connected via a communications network, purchasing a product – receiving a purchase order. Eastman explicitly discloses that the marketplace is for distributors, manufacturers as well as paint and coating formulators and their customers [Page 2, Fourth full paragraph].

In that the product formulating aid, Blend-pro, is already available electronically using a database, the obvious next step would be to offer it via the Internet – in order to address a wider market. The provision of such a tool, in an Internet context – such as on a chemical marketplace website as disclosed in Eastman – would have been obvious to facilitate sales of products that are most appropriate to a customer's needs.

Therefore, the examiner reasserts that the application of a readily available electronic product formulating tool in large, full service Internet chemical marketplace is proper. A re-statement of the rejection made in paper 16 – 11/19/03 - is made below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 12, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article "Eastman Chemical Company..." (Press Release. March 17, 2000) in view of

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the software package “BlendPro” taught in the article “Solvents – continuing to evolve for the future” (Beers et al. 1998. Pigment and Resin).

“Eastman” discloses the launch of an Internet marketplace where material suppliers, distributors, manufacturers, as well as paint and coating *formulators* offer their products to industrial consumers [Page 2]. More generally, the article speaks to the widespread recognition of “formulators” as commercial entities who serve to create and sell specific chemical compounds to end-users. “Eastman” also discloses that these commercial entities sell their products via the Internet.

“Eastman” does not teach a system or method where users ordering from a formulator online are given a tool that aids them in finding chemical customized products using their own chosen starting point formulation and their desired specifications.

“BlendPro” helps *formulators* develop coatings and various materials (chemicals) according to their design specifications. The unique challenge for a formulator is to design systems or chemicals that meet environmental standards as well as other performance characteristics, such as evaporation point, viscosity, etc. [Pgs. 2, 4]. The program uses a database that stores available solvents (starting point formulation) and solubility maps of commercially available resins. Physical properties, such as density, flash point, evaporation time, viscosity and solubility parameters can be easily calculated. In order to *re-formulate* the solvent blends, the operator (the end user) defines which properties are to be reformulated and what restrictions exist – which properties of the solvent blend are critical and which allow some degree of flexibility (inputting of starting point formulation and target characteristics). The *re-formulation* module of BlendPro then calculates which solvent blend matches best the technical

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constraints at the lowest cost [Page 5] (modify the starting point formulation based on target characteristics).

Using BlendPro in various contexts – for solvents, cleaning formulations, coatings, etc. - drastically reduces the time of the development process, which normally involves lengthy trial and error laboratory tests. BlendPro aids formulators in efficiently keeping up with the changing technical requirements and demands in various end-use applications of chemical solvents. [Page 6].

It would have been obvious to one skilled in the art at the time to modify e-commerce enabled formulators, as disclosed in “Eastman”, to provide customers with a product selection tool that aids them – the customers - in creating a custom chemical composition from a starting point using their desired specifications, as taught by BlendPro., in order to avoid a lengthy and inaccurate development process and further to aid the customer in efficiently keeping up with changing technical requirements. [Please note the reference to commercial activity in Beers et al. – Page 5, where production of a re-formulated material is made within the context of “lowest cost”].

Claims 9, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article “Eastman Chemical Company...” (Press Release. March 17, 2000) in view of the software package “BlendPro” taught in the article “Solvents – continuing to evolve for the future” (Beers et al. 1998. Pigment and Resin), as applied in claims 6 and 20, in further view of the service provided by WorldWideTesting.com as discussed in the article “WorldWideTesting.com...the Missing Link” (Press Release. June 22, 1999).

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The system of BlendPro/"Eastman" does not provide that the chemical product data further comprises testing result data stored in the database in response to a sample-testing request.

"WorldWideTesting.com" teaches an Internet-enabled third party laboratory testing web site – worldwidetesting.com [WWT]. The article teaches that WWT partnered with an Internet-based chemical product exchange, ChemConnect, in order to provide end-users with analytical test results for a specific product that they are purchasing [Page 2]. Buyers are able to see the actual product quality and pay competitive prices for the commodities (payment validation and confirmation). The service allows purchasers to make more informed buying decisions in a global environment.

It would have been obvious to modify the chemical product purchasing system of BlendPro/"Eastman" to include the ability for a user to check the integrity and quality of a particular order using a testing service, as taught by the cooperation between WWT and ChemConnect, in order to aid consumers in making more informed and accurate buying decisions.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article "Eastman Chemical Company..." (Press Release. March 17, 2000) in view of the software package "BlendPro" taught in the article "Solvents – continuing to evolve for the future" (Beers et al. 1998. Pigment and Resin), in further view of the service provided by WorldWideTesting.com as discussed in the articles "WorldWideTesting.com...the Missing Link" (Press Release. June 22, 1999), as applied in claim 9, in *further* view of official notice regarding e-commerce.



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The system of BlendPro/Eastman/WWT does not explicitly provide for the customer, or end-user, to validate himself/herself in order to use the chemical purchasing system. Official notice is taken that customer registration and subsequent use of passwords or identifying data – such as email address, name, etc. (validation of user) – for entry to a web site is notoriously known in the art of e-commerce. Such customer validation is used for many purposes including, but not limited to, increased efficiency of navigation or purchasing – for example in filling out necessary forms – validation of customer information and credibility as well as tracking of customer habits and purchases – to formulate marketing promotions and targeted advertising. It therefore would have been obvious to modify the chemical purchasing system of BlendPro/Eastman/WWT to have included a customer registration and validation process, as taught by official notice, in order to give the supplier a larger body of information about the customer to draw from in the future.

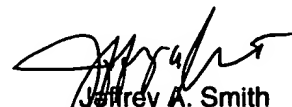
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC



Jeffrey A. Smith  
Primary Examiner